

## REMARKS/ARGUMENTS

Applicants filed a Response After Final on August 6, 2004. Although no amendment was submitted, the Advisory Action indicated that the proposed amendment would not be entered because it raised a new issue that would require further search. Applicants have attempted to resolve this issue with the Office to no avail. Therefore, applicants are filing a Request for Continued Examination and the arguments previously submitted in response to the Advisory Action, which were apparently not considered by the Office.

Claims 7, 9, 11, 13, 14 and 16-27 remain in this application. Review and reconsideration on the merits are requested in view of the following comments.

Claims 7, 9, 11, 13, 14 and 16-27 stand rejected as being unpatentable over Nokubi et al. in view of Kitajima et al. and Kimura et al. This rejection is respectfully traversed for the following reasons.

The Office action acknowledges that Nokubi fails to disclose or suggest a polishing layer comprising a flexible layer formed on the surface of the core. The rejection relies on the other two references for disclosure of this missing element. However, the other references cited by the Examiner relate to completely different types of abrasive materials and would never be considered by one of skill in the art who was looking to modify the Nokubi et al. material. Accordingly, applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to the pending application because the cited references fail to provide the requisite motivation to combine and modify the references to arrive at the present invention.

A determination of obviousness based on a combination of elements disclosed in the prior art must include some reference to a motivation, suggestion or teaching to combine the references. *See, e.g., In re Dance*, 160F.3d 1339, 1343, 48 U.S.P.Q. 2d (BNA) 1635, 1637 (Fed. Cir. 1998). “[A] rejection cannot be predicated on the mere identification...of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” *Ecolchem, Inc. v. Southern California Edison Co.*, 227F.3d 1361, 1375, 56 U.S.P.Q. 2d 1065, 1076 (Fed. Cir. 2000) (quoting *In re*

*Kotzab*, 217F.3d 1365, 1371, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000). A finding of obviousness without particular findings as to the motivation or suggestion in the prior art for combining the references is an impermissible use of hindsight based on the applicants' application. *In re Paulson*, 31 U.S.P.Q. 2d 1671, 1676 (Fed. Cir. 1994).

The Examiner indicates that it would have been obvious to combine the teachings of the cited references to arrive at the present invention and indicates that the motivation to combine is to "retain the abrasive particles on the core during the polishing process." Office action p.3. The abrasive material in Nokubi et al. already provides for retention of the abrasive particles on the core. There is no suggestion or indication in Nokubi et al. that there is a need for improving adhesion and there would be no reason for one skilled in the art to look to other references to include an additional component to provide adhesion. Even if there was a need to look to other art for improving the Nokubi et al. material there is no suggestion or motivation for looking to the Kitajima reference which discloses a segmented grinding wheel for use in a grinding machine or the Kimura reference which discloses a polishing material for polishing a silicon wafer. Applicants respectfully submit that the proposed motivation is insufficient to suggest modifying the Nokubi et al. structure to include a flexible synthetic resin layer as in Kimura et al. or a polishing layer including a bonding layer as disclosed in Kitajima. Certainly, there is nothing within any of the cited references that provides particular motivation to one of ordinary skill in the art to make the combination as proposed by the examiner. Specifically, one of ordinary skill in the art looking at the cited references without the benefit of the applicants' disclosure would not be motivated to modify the references in such a way so as to obtain an abrasive material as set forth in the pending claims. The Office action simply recites the individual elements as disclosed in various prior art references in a piecemeal reconstruction of the applicants' invention. Therefore, applicants submit that the Office has failed to establish a *prima facie* case of obviousness and request that the rejection under 35 U.S.C. §103 be withdrawn.

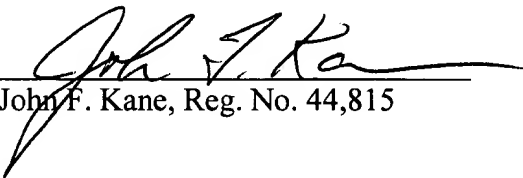
With respect to claims 11 and 13, the Examiner indicates that the abrasive material wherein the polishing layer comprises multiple layers set forth in these claims is unpatentable because the "mere duplication of the essential working parts of a device involves only routine skill in the art." However, the Federal Circuit has made clear, the "reliance on *per se* rules of obviousness is legally incorrect and must cease." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir.

1995). The Examiner's reliance on the above cited *per se* rule fails to meet the burden of establishing a *prima facie* case of obviousness and applicants respectfully request that the rejection be withdrawn.

The Examiner relies on various *per se* rules in rejecting claims 14, 16-18, 20, 21, 24 and 25. These rejections must also fail for the same reasons as set forth above. Accordingly, applicants respectfully request that the rejection be withdrawn with respect to these claims as well.

In view of the above comments, it is respectfully submitted that claims 7, 9, 11, 13, 14, and 16-27 now pending, are in condition for allowance. Reconsideration and allowance of these claims are respectfully requested. If the examiner has any questions or comments which can be addressed over the telephone, applicants urge the examiner to contact the undersigned attorney to address these concerns.

Respectfully submitted,

  
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